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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91273569
Party	Defendant WRB, Inc.
Correspondence address	WRB, INC. 5865 NEAL AVE N / #113 STILLWATER, MN 55082 UNITED STATES Primary email: trademark@hammerschlagen.com 844-942-2548
Submission	Reply in Support of Motion
Filer's name	James Martin
Filer's email	trademark@hammerschlagen.com
Signature	/James Martin/
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Attachments	2022-02-12 Motion to Extend Reply.pdf(108069 bytes)

UNITED STATES DISTRICT PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of:

Application Serial No. **90453221**
For The Mark **Hammer-Schlagen**

DAMM, LLC,

Opposer,

v.

WRB, Inc.,

Applicant.

Opposition Number **91273569**

Applicant's Reply to its Motion to Extend Time to Answer Pending Disposition of its Motion to Suspend

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Applicant WRB, Inc. ("Applicant") replies to the response of Opposer DAMM, LLC ("Opposer") of February 2, 2022, to Applicant's motion of January 28, 2022.

ARGUMENT AND CITATION TO AUTHORITY

The filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere re-argument of the points made in the main brief. TMEP § 502.02; *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1223 n.4 (TTAB 1987) (reply brief, constituting mere reargument given no consideration). For this reason, Applicant will limit the scope of its reply brief to new matters presented by and actions taken by Opposer.

Opposer's Reiteration Of Claims

Opposer responds with substantially the same claims it first raised in the preexisting Federal Proceeding and repeated that which it presented on January 18, 2022, to an earlier motion, a majority of which is not germane to this motion. Applicant has already addressed these matters in its reply of February 7, 2022 to said earlier motion; Applicant directs this tribunal to the same in the event it desires to consider these issues as

they related to this motion, which include, but are not necessarily limited to, Opposer's intellectual property infringement, Applicant's enforcement of said infringement, and matters of the preexisting Federal Proceeding as well as Opposer's allegations of tactical gamesmanship, non-use of the applied-for mark, fraud, genericness, descriptiveness, delay, and prejudice as raised in Opposer's response to this motion. Applicant provides a more specific reply as to Opposer's response as follows.

Bad Faith / Delay

Opposer presents the factual contention that "Applicant's motion for extension of time is not made in good faith, but rather is made for purposes of delay." Opp. Resp. (2/2/22) p.1. Opposer presents other supporting factual contentions, namely that Applicant is "attempt[ing] to avoid filing an answer," "applicant seeks to avoid the facts," Applicant is "delay[ing] having to explain the misrepresentations made in its application," and Applicant is not "diligently prepar[ing] an Answer" because Applicant is engaging in "mere tactical gamesmanship." Opp. Resp. (2/2/22) p.2. However, Opposer presents no evidence in support of its claims; no such evidence exists, nor will any be uncovered after a reasonable opportunity for further investigation and discovery. The record clearly demonstrates Applicant is pressed with other litigative matters, and Opposer presents no contradictory evidence to demonstrate otherwise.

Instead of addressing the factual contentions and legal conclusions made by Applicant that justify an extension of time, Opposer made the factual contention that Applicant is "[d]elaying the filing of an Answer because there is a pending motion to suspend." Opp. Resp. (2/2/22) p.1. Despite what Opposer would have this tribunal believe, Applicant has not made such a claim and Opposer fails to present any evidence to suggest that such a claim has been made; again, no such evidence exists nor will any be uncovered after a reasonable opportunity for further investigation and discovery. Additionally,

Opposer knew of the litigative efforts pressing Applicant at the time it filed its response as Opposer is actively participating in those litigative efforts. To be direct to the point, Opposer does not dispute the fact that Applicant is pressed by other litigative efforts, said efforts are causing Applicant's Answer to be delayed, and such facts warrant extension; instead, Opposer presented factual contentions contradictory to the evidence it had in its possession at the time it presented its contentions to the Board. These actions caused Applicant to be forced into the position to make a reasonable inquiry into whether or not this reply would be beneficial to the Board, as well as its preparation and filing. In so doing, Applicant's ability to prepare and file its Answer was furthered hindered by the press of this additional litigative effort. *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383-84 (TTAB 2001) (the press of other litigation constitutes good cause to extend).

At the same time Opposer filed its response to this motion, it chose to make a brand-new motion. In so doing, Applicant was pressed with yet another litigative effort which further hindered Applicant's ability to prepare and file its Answer. The press of this additional litigative effort, namely having to make another reasonable inquiry and prepare a response for filing, further warrants extension. *Id.*

Prejudice

Opposer suggests that it "will [be] unduly prejudice[d]" if this motion to extend is granted. Opp. Resp. p.2. However, there is no indication that Opposer will be prejudiced by the delay and Opposer presents no facts or law in support. That is, there is no indication that Opposer's ability to litigate the issues of this case would be adversely affected by the delay. See *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997) (prejudice typically results if witnesses or evidence become unavailable as a result of the delay). Any delay in this TTAB Proceeding will not prevent Opposer from being able to litigate the

issues presented or seek applicable discovery; it may do so in the Federal Proceeding just as it could before Opposer commenced this TTAB Proceeding. Even if this TTAB Proceeding is not suspended, Applicant's filing of a late Answer is not prejudicial to Opposer. *DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000). The only prejudice suffered is on the part of Applicant; in example, the registration of Applicant's senior trademark rights are not being allowed to move forward.

To demonstrate Opposer's lack of seriousness regarding its claims of prejudice, the fact exists that Opposer has not sought to stay the Federal Proceeding pending a decision by the Board in this TTAB Proceeding. If it had, it might have been able to show some prejudice in proceeding with this substantially identical action; but the district court would almost certainly reject any such motion because Applicant is complaining of Opposer's violations of the Lanham Act and unfair competition in the Federal Proceeding, and Applicant is seeking both damages and injunctive relief against Opposer, none of which can be resolved by the Board. TBMP § 102.01; Trademark Act § 17-18, § 20, § 24; 15 U.S.C. § 1067-1068, § 1070, § 1092; *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) ("[T]he Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings."), *aff'd unpub'd*, 240 F. App'x 865 (Fed. Cir. July 11, 2007), *cert. den.*, 552 U.S. 1109 (2008); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp.*

v. White, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Conolty v. Conolty O'Connor NYC, LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082-83 (TTAB 2014). Again, Opposer's legal conclusions are not supported by existing law.

Motions Are Potentially Responsive

As this motion to extend was filed before Opposer's new motion for default, Applicant recognizes that this tribunal could treat Applicant's motions and replies in this TTAB Proceeding as Applicant's response to Opposer's motion for default as all other outstanding motions are fully briefed and awaiting disposition. TBMP § 312.01; *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (motion to accept late answer filed before notice of default issued treated as response to notice of default). Though Applicant is diligently working on making a reasonable inquiry into Opposer's new motion and intends on preparing and filing such a response on or before February 22, 2022, Applicant notes the Board could rule on Opposer's motion if this tribunal does not wish to wait for the filing of said response. After all, Applicant has already shown good cause as to why default judgment should not be entered against it because: (1) the delay in filing its Answer was not the result of willful misconduct or gross neglect on the part of Applicant; (2) Opposer will not be substantially prejudiced by the delay; and (3) Applicant has a meritorious defense to the action. TBMP § 312.02; *Fred Hayman* at 1557; *DeLorme Publishing* at 1224. In the event this tribunal decides to dispose Opposer's new motion, Applicant requests the tribunal to consider the following in the interest of promoting judicial economy and in respect for the Board's time.

In demonstration of a meritorius defense, Applicant directs the Board to the arguments and presentation of evidence in Applicant's motions and replies in this TTAB

Proceeding as well as Applicant's demonstration of its willingness to defend the matter on its merits. See *DeLorme Publishing* at 1224 (A "meritorious defense" under the *Fred Hayman* analysis does not entail an inquiry into the merits of the underlying case, merely some sort of plausible response to the allegations made in the notice of opposition and a willingness to defend the matter on its merits is all that is required). In the filings of this TTAB Proceeding, Applicant has responded to all three claims for relief stated by Opposer as well as addressing substantially all of the statements made in Opposer's opposition notice of December 21, 2021, including, but not limited to: Opposer's claim that Applicant's marks are generic; a prima facie demonstration that Applicant has superior trademark rights to those of Opposer's alleged common law trademark rights; that Applicant's products and Opposer's products are substantially the same; that Applicant has not engaged in fraud or made any misrepresentations to the Board; that Applicant has used the applied-for mark on the class of goods described in the application under the applied-for marks prior to the date claimed by Opposer that no such activities ever existed; the identification of Applicant's intellectual property; and the likelihood of confusion between Applicant's family of intellectual property and Opposer's mark. To be direct to the point, Opposer's claim to the Board that Applicant is in default is not supported by current law.

If this tribunal decides to dispose of the pending motions without first receiving Applicant's response to Opposer's motion for default, it should be done in such a way as to allow Applicant time to submit its Answer. *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (applicant allowed time after disposing of the motion for default judgment to submit its answer). This is because Applicant would finally be free to prepare its Answer for filing instead of being pressed by other litigative efforts within this TTAB Proceeding (such as filing and preparing its response to Opposer's new motion); please keep in mind that it is still difficult for Applicant to remit its Answer due to the pressing litigation of the

Federal Proceeding. Regardless of how this tribunal disposes of the pending motions, judicial economy is best promoted by setting the date by which Applicant's Answer is due as 30-days following the date on which this TTAB Proceeding is resumed. *Djeredjian* at 1615.

CONCLUSION

Factual contentions presented to the Board by Opposer are refuted by evidence Opposer had in its possession, legal conclusions presented by Opposer are not supported by existing law, and Opposer fails to refute any factual contention or legal conclusion presented by Applicant in this motion. As such an order from the Board to extend the time for Applicant to Answer continues to be warranted. Applicant again respectfully requests that this motion to extend be duly granted.

Dated: February 12, 2022

Respectfully Submitted,

WRB, INC.

/s/ James Martin
By its CEO, James Martin
5865 Neal Ave N / #113
Stillwater, MN 55082
(844) WHACK-IT
trademark@hammerschlagen.com

Applicant

CERTIFICATE OF SERVICE

I hereby certify that, on February 12, 2022, a copy of the foregoing motion was sent via e-mail to Opposer's counsel of record, as follows:

Paul Dietz
DIETZ LAW OFFICE LLC
4975 Wilderness Lake Cir
Elko New Market, MN 55020
paul@dietzlawoffice.com

/s/ James Martin
WRB, Inc.
By its CEO, James Martin